REMARKS

The Final Office Action mailed February 3, 2004, considered and rejected claims 1-15 and 27-33. Claims 1-3, 9-15 and 27-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Haverstock (U.S. Patent No. 6,678,738) and claims 1 and 4-8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cottrille (U.S. Patent No. 6,581,096)[1].

No claims have been cancelled or added by this amendment. Accordingly, claims 1-15 and 27-33 remain pending for reconsideration. Of these pending claims, Applicants have amended each of the independent claims at issue (1, 9 and 27).

Claim 1 is directed to a method of using a decision engine to create a document for use by a client that is customized according to attributes associated with the client. The recited method includes a server application receiving a client request for a document that the server application is configured to generate from a script. The server application then requests a separate decision engine to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made. Upon receiving an identification of the appropriate content from the decision engine the server application creates the document and incorporates into the document the content that was selected by the decision engine. Finally, the document is transmitted to the client.

As described throughout Applicants' specification, this claimed embodiment is useful for abstracting the decision process away from the server application. "In other words, the decision criteria are abstracted from server application 144 and script 146 and are encapsulated in decision engine 148. In order to request a decision identifying the appropriate content, server application 144 merely requests decision engine 148 to identify the appropriate content without informing the decision engine of any decision criteria that are to be used to make the decision." Page 15, ll. 2-7. This can be beneficial, because "abstracting the decision criteria from [the] server application 144 and script 146 into decision engine 148 enables the decision criteria to be

[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

modified as desired without requiring the code of the server application or script to be modified." Page 15, ll. 8-10.

With particular regard to claim 1, Applicants respectfully submit that Cottrille does not anticipate the recited claim. For example, Cottrille fails to disclose, either explicitly or inherently, a method for creating a document in which a server application makes a request to a decision engine that is separate from the server application for content to be selected for a document based on one or more attributes of a client and without the server application actually specifying to the decision engine the at least one attribute or how the selection of content is to be made. In fact, Cottrille does not even disclose a decision engine that is separate from a server application at all. With particular regard to this point, the Examiner only suggests that the server itself is the decision engine. This interpretation, however, infers that the server application and decision engine are one in the same, which would not allow the decision for selecting content to be abstracted from the server application, as described above.

Accordingly, for at least this reason, Cottrille clearly fails to support a *prima facia* case of anticipation. Furthermore, inasmuch as Cottrille cannot be used as a reference to support an obviousness rejection[2], Applicants respectfully submit that the rejections to claims 1 and 4-8, which rely on Cottrille, should be reconsidered and withdrawn.

The only remaining rejections of record rely on Haverstock, a newly cited reference. Haverstock is generally directed to a method and system for enabling non-HTML objects to be embedded within HTML objects and for enabling a server to honor requests for HTML documents as well as non-HTML documents. (Col. 2, ll. 58-63.) As disclosed, Haverstock is able to retrieve and return the non-HTML documents to a client by using a translator that translates non-HTML objects into HTML formats that can be displayed by the client browser.

As more particularly described in the passage cited by the Examiner (Col. 3, ll. 54-65),

> a user submits a URL-based request for an object via browser 28. The request is passed to server 14 using HTTP (or other protocol). Server 14 receives the request via HTTP server module 30 and passes object location information to interface module 32 via a URL interface 46. URL interface 46 transmits that information to non-HTML server module 24. Non-HTML server module 24

[2] As mentioned in the last amendment, Cottrille was commonly assigned to Microsoft Corporation, the assignee of the present application at the time of the present invention. Accordingly, under 35 U.S.C. 103(c), Cottrille cannot be used for an obviousness rejection because it only qualifies as prior art under 35 U.S.C. 102(e) and because the present application was filed after November 29, 2000, such that it falls within the provisions of the AIPA.

> retrieves the requested object and passes it to interface module 32. A HTML translator portion 44 of interface module 32 translates the non-HTML object to a HTML representation of the requested object and the HTML representation is returned to browser 38 via HTTP server module 30.

This passage, as well as the remainder of Haverstock fail, however to describe or suggest a method in which a server application receives a request for a document and then sends its own request to a separate decision engine for content based on client attributes and without specifying the client attributes, as claimed. In fact, Haverstock fails to even mention that content is selected according to any attributes at all, let alone the client attributes. Instead, Haverstock teaches that a client request for a document having a non-HTML object is received by a module which then passes the object location on to a non-HTML server module which is configured to obtain the non-HTML document. The non-HTML object is then obtained and passed back to the server module 30 through the interface module 32, where it is translated into HTML. In summary, Haverstock fails to disclose selecting content based on attributes or any method for abstracting the selection process, as claimed in the pending claims.

For at least these reasons, Applicants respectfully submit that claim 1 and corresponding depending claims are neither anticipated by nor made obvious by Haverstock.

Applicants also submit that Haverstock fails to anticipate or make obvious claims 9 and 27, as well as the rest of the claims that depend therefrom. In particular, Haverstock fails to anticipate or make obvious a method, as recited in claims 9 and 27, of creating a document for use by a client that is customized according to specified attributes associated with the client. In fact, as mentioned above, Haverstock fails to even mention that the creation of a document is altered in any way to accommodate the attributes of a client.

Haverstock also fails to disclose the assembly of a script for creating a document, as further claimed, wherein upon processing a first statement encoded in a script, the server issues a request for the decision engine to select a second portion of the script based on at least one of the specified attributes without the script identifying said at least one specified attribute. Finally, Haverstock also fails to disclose having the server application receive the requested second portion of the script from the decision engine and concatenate the first portion of the script and

the second portion of the script prior to execution of the script and creation of the document, as claimed.

In response to Applicants' previous arguments, made in the last amendment, the Examiner has stated that "by Haverstock disclosing an interface module within the server, making a decision as to what content is to be retrieved based from the user's request and that content being incorporated into the document, it is obvious to the Examiner that additional scripts must be used to retrieve, translate the content into the proper format, and combine the scripts to produce the final document." (Page 7, last 2 lines thru Page 8, line 3). Applicants respectfully disagree.

Although Haverstock discloses an interface module, it is only disclosed as being used to transmit object location information to a non-HTML server 24 in a format supported by non-HTML server 24 (via the URL interface) and to translate non-HTML objects received from the non-HTML server 24 into HTML, which are then passed back to the HTTP server module. (Col. 3, ll.57-65 and Col. 5, ll. 38-44). Accordingly, Haverstock does not support the assertion that the interface module makes a decision as to what content is to be retrieved based from the user's request. Instead, at the very most, the interface module could be interpreted as identifying where the requested content is located. Nevertheless, even assuming, *arguendo*, that the assertion was correct, the recited claims specify more particularly that the decision engine selects content based on the **attributes** of the client, not a user's **request**.

Furthermore, whereas the interface module of Haverstock passes the request (Col. 5, ll. 38-40) on to the non-HTML module, the claims recite that the attribute is not included with the request or script. Accordingly, whereas the pending claims recite embodiments in which the selection of content is abstracted from the server application, Haverstock actually appears to suggest the opposite. In particular, Haverstock appears to suggest that the decision as to what content is selected is made at the server application, rather than having it abstracted to a separate decision engine.

Finally, it should also be pointed out that the Examiner's assertion that an element would be "obvious" (see page 8, line 2) in view of the cited art infers the art does not anticipate the claims at issue, but rather at most makes it obvious.

If the Examiner continues to pursue the arguments made in the Final office action, based on Haverstock and Cottrille, Applicants respectfully request that the Examiner identifies, by reference numeral, the Haverstock/Cottrille components/modules that are considered to be analogous with the server application and decision engine of the present application so that the Applicants will be provided a fair opportunity to respond to the arguments.

Finally, with regard to the Examiners assertion that "the existence of a decision engine is inherent in a server where scripts are combined", such as, for example, with "if statements" fails to recognize the distinction drawn throughout the application and enabled by the recited claim embodiments. In particular, the background section of Applicants' own specification acknowledges that prior art systems utilized "if/then" clauses. However, these systems are inadequate in some situations, such as when new content is added. (Page 4)

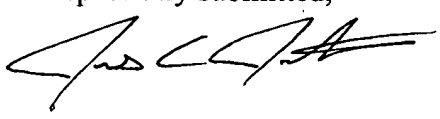
Nevertheless, Applicants have amended the claims to more clearly recite that the server application is separate from the decision engine, thereby distinguishing from the art (e.g., Haverstock) and the perceived inherency in which the "decision engine" comprises the server application.

For at least the forgoing reasons, Applicants respectfully submit that the pending claims are neither anticipated by nor made obvious by the art of record and are, therefore, in condition for prompt allowance.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 24 day of March 2004.

Respectfully submitted,



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